

### **REMARKS/ARGUMENTS**

The Office Action mailed April 22, 2004, and the references cited therein have been carefully reviewed in light of the Examiner's helpful comments and suggestions.

As a result of the Office Action, claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,693,778 to Kahn in view of Lagoni. These references have been carefully reviewed but are not believed to show or suggest Applicant's claimed invention in any manner. Reconsideration and allowance of the pending claims is therefore respectfully requested in view of the following remarks.

According to MPEP 2142, in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations.

In the present case, the Examiner has taken a position that "Kahn fails to further suggest wherein the incoming-call detection circuit (i.e. modem) includes a caller identification circuit for identifying the caller's phone number and a brief message and transformation circuit for transforming messages into visual messages and outputs said visual signals. However, Lagoni et al teach a television receiver includes a detector unit and a telephone network interface circuitry that allows the

receiver to receive and process the Caller ID signal for display on the television screen or monitor when an incoming call is detected. " *Office Action*, pages 2-3.

Then the Examiner has provided the following as reasoning for combining the two references: "Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teaching of Lagoni et al into view of Kahn in order to assist user in receiving telephone calls while entertainment devices are being in use." *Office Action*, Page 3.

First, the Examiner has provided no support for the reasoning set forth as the suggestion to combine the references, and therefore it stands merely as the Examiner's unsupported conclusion and impermissible hindsight. More specifically, underlying the present invention is not "assisting a user in receiving telephone calls while entertainment devices are being used" as suggested by the Examiner, but rather, it is a caller identification device that allows for the adjustment of volume and displays the caller's telephone number on, for example, a TV, so that a user will not miss a telephone call.

Second, there is no reasonable expectation of success by combining the teachings of the Kahn reference with the teachings of the Lagoni reference. In fact, according to MPEP 2143.01, the proposed modification cannot render the prior art unsatisfactory for its intended purpose. That is, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. Kahn teaches an apparatus for automatically adjusting an electronic device output in response to an incoming telephone call. Modifying the Kahn reference to combine

with the teachings of the Lagoni reference, that is, to provide a television receiver having a telephone network interface circuitry, would render the device of Kahn inoperable, and, for the sake of argument, even if they were combinable, would require other and more complicated elements to render the combination operable. In view of the foregoing, it is respectfully submitted that claims 4 and 8 are patentable over the prior art combination.

Claims 7 is dependent from claim 4 and is therefore allowable for the same reasons as in claim 4.

Each issue raised in the Office Action mailed April 22, 2004, has been addressed and it is believed that claims 4, 7, and 8 are in condition for allowance. Wherefore, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,  
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